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BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 GATEHOUSE ROAD
SUITE 500E
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

PHONE: (703) 205-8000
FAX: (703) 205-8050

BSKB, LLP

Fax

To: Examiner CollinsFrom: Kristi RupertFax: 703/746-5032Pages: 8

Phone:

Date: 12-30-03 1-2-04Re: 09/697,719

CC:

☐ Urgent☐ For Review☐ Please Comment☐ Please Reply☐ Please Recycle

• Comments:

Response filed 6-6-03

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Papers Filed Herein on: June 6, 2003 23

DOCKET NO.: 0020-4744P

ATTY.: GMM/KUR

APPLICANT: NIKOLAI NAKAZHUKA et al.

USN: 09/03, 719 FILED: 06.27.2010

PAT NO.: _____

☐ New Application with Transmittal Letter

☐ Utility ☐ Design ☐ CIP ☐ PCT ☐ Provisional

☐ Filing Under 37 CFR 1.53(b) ☐ CONT ☐ DIV

☐ Filing Under 37 CFR 1.53(d) (CPA)

☐ Specification Consisting of: _____ pages

☐ Combined Declaration & Power of Attorney

☐ Assignment / Convey Letter

☐ Letter to Official Drafterman

☐ Drawings _____ Sheets ☐ Formal ☐ Informal ☐ Red-link

☐ Completion of Filing Requirements, PCT/DIV/EO/805 or PTO-1583 and Executed Declaration

☐ Priority Document(s) / Cover Letter No. Doc. _____

☐ Amendment

☒ Transmittal ☐ Large Entity ☐ Small Entity

☒ Response

☐ Information Disc. Stmt. PTO-1449(s) _____ doc(s)

☐ Notice of Appeal ☐ Appeal Brief

☐ Issue Fee Transmittal

☐ FEES: _____

☐ Letter: _____

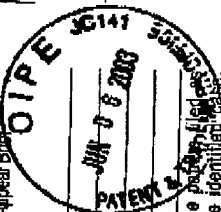
☐ Other: _____

Receipt is hereby acknowledged of the papers filed as indicated in connection with the above identified case.

COMMISSIONER OF PATENTS AND TRADEMARKS

Due Date: 0-7-03

Handwritten: _____



JAN 05 2004

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PATENT
0020-4764P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Hiroki NAKAJIMA et al. Conf.: 4838

Appl. No.: 09/697,719 Group: 1638

Filed: October 27, 2000 Examiner: COLLINS

For: METHOD FOR GIVING RESISTANCE TO WEED
CONTROL COMPOUNDS TO PLANTS

LARGE ENTITY TRANSMITTAL FORM

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 6, 2003

Sir:

Transmitted herewith is a Reply to Restriction/Election Requirement in the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☐ Petition for _____ () month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$0.00 for the extension of time.
- ☒ No fee is required.
- ☐ A check in the amount of \$0.00 is enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

Appl. No. 09/697,719

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Gerald M. Murphy, Jr., #28,977

KLR
GMM/KLR:gml
0020-4764P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s)

(Rev. 04/30/03)

PATENT
0020-4764P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Hiroki NAKAJIMA et al. Conf.: 4838
Appl. No.: 09/697,719 Group: 1638
Filed: October 27, 2000 Examiner: Collins
For: METHOD FOR GIVING RESISTANCE TO WEED CONTROL
COMPOUNDS TO PLANTS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

June 6, 2003

Sir:

In response to the Office communication dated May 7, 2003, the following remarks are respectfully submitted in connection with the above-identified application.

Application No. 09/697,719

REMARKS

Claims 1-69 are pending in the present application. No new matter is inserted into the application.

Restriction Requirement

In response to the Restriction and Election Requirement, Applicants elect Group VI, claims 1-7, 20-25, 28-31, 37, 43, 45, 47, 49, and 51, drawn to a method of producing a herbicide resistant plant comprising transforming a plant with a polynucleotide encoding a protoporphyrinogen IX oxidase protein derived from soybean and lacking the ability to oxidize protoporphyrinogen IX, a plant produced therefrom and methods of using said plant, with traverse.

Applicants respectfully submit that the Examiner has not established that there is an undue burden in searching for all claims as required by MPEP § 803. The "undue burden" requirement created by the U.S. Patent and Trademark Office is recited in MPEP § 803:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on its merits, even though it includes claims to independent and distinct inventions.

The Examiner states, "the search required for one of the groups is not required for another..." On the other hand, the Examiner

Application No. 09/697,719

states that all of the claims are classified within the same class, (i.e., class 800). The groups only differ by subclassification, but even then, Groups I, II, VIII, IX, XI, XII, and XIII share the same subclassification of subclass 300, Groups III, IV, and V share the same subclass of 288, and Groups VI, VII, and X share the same subclass of 278. Applicants do not believe that an undue burden would be placed on the Examiner to rejoin the claims, especially when the claims share the same classification.

For these reasons, Applicants believe that an undue burden for searching does not exist, and respectfully request that the Examiner rejoin all claims of the present invention and examine them together in the present application. In particular, Applicants respectfully request that the Examiner rejoin the claims of Groups VI and VII, based upon their identical subclassifications. This rejoinder would only require the addition of claims 26 and 27 to the claims of Group VI. Applicants do not believe that an undue burden would be placed on the Examiner to add two claims to the elected claim set.

An early and favorable action on the merits of the present application is earnestly solicited.

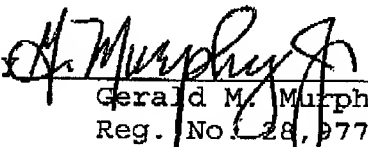
If the Examiner has any questions concerning this application, the Examiner is requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at (703) 205-8000.

Application No. 09/697,719

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Gerald M. Murphy, Jr.,
Reg. No. 28,977


GMM/KLR

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